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EXAMINER	
MOORE, SUSANNA	

ART UNIT	PAPER NUMBER
1624	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/590,924	BLETTNER ET AL.	
	Examiner	Art Unit	
	SUSANNA MOORE	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 14-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/28/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group (I), claim(s) 1-12 and 14-18, drawn to triazolo[1,5-a]pyrimidines.

Group (II), claim(s) 13, drawn to intermediates of the compounds of Group (I).

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a) Group I -Group Il lack unity of invention since under 37 CFR 1.475:

> Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features…those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The technical feature corresponding to group I, formula (I), is the substituted 7-aminotriazolo[1,5-a]pyrimidine scaffold. Group II are drawn to intermediates of compounds of Group (I). The special technical feature of Group (I) can be found in reference US 7329663. Therefore the above claims, are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a common technical feature. which fails to define a contribution over the prior art. Accordingly, unity of invention is considered to be

lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Furthermore, since the groups do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to the groups restricted above. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Further, even if unity of invention under 37 C.F.R. § 1.475(a) were not lacking, under 37 C.F.R. § 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

(1) a product and a process specially adapted for the manufacture of said product; or
(2) a product and a process of use of said product; or
(3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product;
(4) a process and an apparatus or means specifically designed for carrying out the said process; or
(5) a product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 C.F.R. § 1.475(c): If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

Therefore, because the claims are drawn to products and multiple methods of use of compounds of formula (I), according to 37 C.F.R. § 1.475(e), the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. The claims in the instant application lack unity of invention and should be limited to one product, one method of use, or one process of preparing the product.

During a telephone conversation with Andrew D. Meikle on February 28, 2008 a provisional election was made without traverse to prosecute the invention of Group (I), claims 1-12 and 14-18. Affirmation of this election must be made by applicant in replying to this Office action. Claim 13 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: 7-Amino-(2,6-dichlorophenyl)triazolo[1,5-a]pyrmidines as Fungicides.

This is just a suggestion. Please feel free to change the title to accurately describe the invention.

Claim Objections

Claim 3 are objected to because of the following informalities: the phrase "groups R^a" should be replaced with "R^a groups." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "heterocycle" is vague and ambiguous. "Heterocycle" is the name of a compound whose valency is complete. It cannot be used as a substituent because it has no free valency. Thus, please replace with the correct substituent name.

Regarding claims 1-12 and 14-18, the term "heterocyclyl is vague. The Specfication on page 8 includes a list of groups, however, the list uses open-ended language, e.g. "for example." What is not included? The claims are too broad in that there is no proper support in the Specification for "heterocyclic groups." *In re Wiggins*, 179 USPQ 421.

The phrase, "for their part" on page 27, the second to the last line, is vague. The Examiner suggests the removal of this phrase.

Claim 2 recites the limitation "eight-membered heterocyclyl" in the definition of R^1 and R^2. However, this definition is not found in claim 1, from which claim 2 depends. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "haloalkyl" in the definition of X. However, this definition is not found in claim 1, from which claim 12 depends. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "alkyl" in the definition of X. The definition in the Specification allows for C_1-C_8. However, this definition is not found in claim 1, from which claim 12 depends. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "alkoxy" in the definition of X. The definition in claim1, from which claim 15 depends, is only C_1-C_4. The same situation exists for "haloalkoxy, alkenyloxy or haloalkenyloxy" in claim 15. There is insufficient antecedent basis for this limitation in the claim.

Also, in claim 14, the term "alkyl" the definition in claim1, from which claim 14 depends, is only C_1-C_4.

Regarding claim 1, the term "preferably" is a range within a range. Thus, claim 1 is vague.

Regarding claim 3, the term "R^a" lacks antecedent basis.

Regarding claim 2, the term "C_3-C_6-cycloalkyl-C_1-C_4-alkyl" lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 8, 12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfrengle et. al. (US 5994360).

The reference teaches compounds of formula (I), wherein R^1 and R^2= $(CH_2)_2CH(CH_3)(CH_2)_2$ and X= methyl. See column 12, table I, example 8. The compositions are taught in column 7, line 60 and the method of use in column 7, line 58. Thus, said claims are anticipated by Pfrengle et. al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tormo I Blasco et. al. (US 20060211711 A1).

The instant Application claims compounds of formula (I), wherein X= methoxy, R^2= hydrogen, R^1= $C(CH_3)_2CCH$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

Tormo I Blasco et. al. teaches compounds of formula (I), wherein X= chloro, R^2= hydrogen, R^1= $C(CH_3)_2CCH$ and the phenyl at the 6-position of the bicyclic skeleton is 2-chloro-6-fluorophenyl. See page 10, Table 1, compound I-6.

The only difference between the claimed compound and the reference is a) the substitution of X, and b) the substitution at the phenyl ring at the 6-position of the bicycle.

a) The substitution at X, Applicant's methoxy versus chloro. The genus on page 1 of the Specification of the reference teaches that the methoxy and chloro are alternatively useable, see page 1, paragraph 0008.

b) The substitution of the phenyl ring at the 6-position of the bicycle, 6-fluoro versus 6-chloro. The genus on page 1 of the Specification of the reference teaches that the chloro and fluoro are alternatively useable, see page 1, paragraph 0002. This is only one example found in the reference. Thus, said claims are obvious.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tormo I Blasco et. al. (US 20060211573 A1).

The instant Application claims compounds of formula (I), wherein X= cyano, R^2= hydrogen, R^1= $C(CH_3)CHCH_2$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

Tormo I Blasco et. al. teaches compounds of formula (I), wherein X= chloro, R^2= hydrogen, R^1= $C(CH_3)CHCH_2$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl. See paragraph 0071 on page 5 and Table A on page 6, No. A-1.

The only difference between the claimed compound and the reference is at X, chloro versus cyano. The genus on page 1 of the Specification of the reference teaches that the cyano and chloro are alternatively useable, see page 1, paragraph 0002.

This is only one example found in the reference. Thus, said claims are obvious.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tormo I Blasco et. al. (US 20060241128 A1).

The instant Application claims compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= CH_2CH_3 and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

Tormo I Blasco et. al. teaches compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= CH_2CH_3 and the phenyl at the 6-position of the bicyclic skeleton is 2,4-dichlorophenyl. See paragraph 0101 and Table A, No. A-1.

The only difference between the claimed compound and the reference is the substitution at the 4- and 6-position of the phenyl ring at the 6-position of the bicycle. The compounds are positional isomers. The MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) …are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). This is only one example found in the reference. Thus, said claims are rendered obvious.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et. al. (JP 2002308879 A).

The instant Application claims compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= isopropyl and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

Miyahara at. el. teaches compounds of formula (I) as fungicides, wherein X= methyl, R^2= hydrogen, R^1= isopropyl and the phenyl at the 6-position of the bicyclic skeleton is 2-chloro-6-fluorophenyl. See compound 7, columns 63-64.

The only difference between the claimed compound and the reference is the substitution at the phenyl ring at the 6-position of the bicycle, a 6-chloro versus 6-fluoro. The reference teaches a guidepost where the 6-position is a fluoro, see the fifth to the last compound on page 27 in the table. Thus, the chloro and fluoro are alternatively useable at the 6-position of the phenyl. This is only one example found in the reference. Thus, said claims are obvious.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et. al. (US 7329663 B2).

The instant Application claims compounds of formula (I) as antifungals, wherein X= methyl, R^1 and R^2= 2-methylpyrrolidnyl, and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

The copending Application teaches compounds of formula (I) as antifungals, wherein X= chloro, R^1 and R^2= 2-methylpyrrolidnyl and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl. See column 64, example 18.

The only difference between the claimed compound and the reference is the substitution at X, chloro versus methyl. The genus in column 3 of the disclosure of the reference teaches that the chloro and methyl are alternatively useable, see column 4, lines 39-45.

This is only one example found in the reference. Thus, said claims are obvious.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tormo I Blasco et. al. (US 7094894 B2).

The instant Application claims compounds of formula (I) as antifungals, wherein X= cyano, R^1= ethyl, R^2= hydrogen, and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

Tormo I Blasco et. al. teaches compounds of formula (I) as antifungals, wherein X= cyano, R^1= ethyl, R^2= hydrogen and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichloro-4-methylphenyl. See column 11, Table 12 and column 13, Table A, No. A-2.

The only difference between the claimed compound and the reference is the substitution at the para position of the phenyl ring, methyl versus hydrogen. Since a methyl group is considered a homolog of hydrogen these compounds are considered equivalent. The MPEP 2144.09 states "Compounds which are… homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH2- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). Also, note *In re Magerlein*, 202 USPQ 473; *In re Wood*, 199 USPQ 137; *In re Hoke*, 195 USPQ 148; *In re Lohr,* 137 USPQ 548.

This is only one example found in the reference. Thus, said claims are obvious.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-30 of copending Application No. 11661566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the I-145 specie on page 67 only differs from the claimed compounds in the following manner:

The instant Application claims compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= $CH(CH_3)C_2H_5$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

The copending Application teaches compounds of formula (I), wherein X= chloro, R^2= hydrogen, R^1= $CH(CH_3)C_2H_5$ and the phenyl at the 6-position of the bicyclic skeleton is 2-chloro-6-fluorophenyl.

The only difference between the claimed compound and the reference is a) the substitution at X, and b) the substitution at the phenyl ring at the 6-position of the bicycle.

a) The substitution at X is chloro versus Applicant's methyl. The genus on page 1 teaches the chloro and methyl are alternatively useable. See page 3, line 5.

b) The substitution at the phenyl ring at the 6-position of the bicycle, 6-fluoro versus 6-chloro. The genus on page 1 of the Specification of the copending Application teaches that the

chloro and fluoro are alternatively useable, see page 2, lines 34-35. This is only one example found in the copending Application. Thus, said claims are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11628852. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 9th specie in Table 60, on page 22, only differs from the claimed compounds in the following manner:

The instant Application claims compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= hydroxymethyl and the phenyl at the 6-position of the bicyclic skeleton is 2,4-difluoro-6-chlorophenyl.

The copending Application teaches compounds of formula (I), wherein X= methyl, R^2= hydrogen, R^1= hydroxymethyl and the phenyl at the 6-position of the bicyclic skeleton is 2-fluoro-6-methylphenyl.

The only difference between the claimed compound and the reference is the substitution at the phenyl ring at the 6-position of the bicycle, Applicant's chloro versus methyl. The genus on page 1 of the Specification of the copending Application teaches that the methyl and chloro are alternatively useable, see page 2, lines 1-3.

This is only one example found in the copending Application. Thus, said claims are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10550571. Although the conflicting claims are not identical, they are not patentably distinct from each other because the I-6 specie in Table 1, on page 28, only differs from the claimed compounds in the following manner:

The instant Application claims compounds of formula (I), wherein X= methoxy, R^2= hydrogen, R^1= $C(CH_3)_2CCH$ and the phenyl at the 6-position of the bicyclic skeleton is 2,4-dichlorophenyl.

The copending Application teaches compounds of formula (I), wherein X= chloro, R^2= hydrogen, R^1= $C(CH_3)_2CCH$ and the phenyl at the 6-position of the bicyclic skeleton is 2-chloro-6-fluorophenyl.

The only difference between the claimed compound and the reference is a) the substitution of X, and b) the substitution at the phenyl ring at the 6-position of the bicycle.

a) The substitution at X, Applicant's methoxy versus chloro. The genus on page 1 of the Specification of the copending Application teaches that the methoxy and chloro are alternatively useable, see page 1, line 26.

b) The substitution of the phenyl ring at the 6-position of the bicycle, 6-fluoro versus 6-chloro. The genus on page 1 of the Specification of the copending Application teaches that the chloro and fluoro are alternatively useable, see page 1, lines 10-11. This is only one example found in the copending Application. Thus, said claims are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10548690. Although the conflicting claims are not identical, they are not patentably distinct from each other because the A-1 specie in Table 3, on page 10, only differs from the claimed compounds in the following manner:

The instant Application claims compounds of formula (I), wherein X= cyano, R^2= methyl, R^1= $CHCH_2$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

The copending Application teaches compounds of formula (I), wherein X= chloro, R^2= methyl, R^1= $CHCH_2$ and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

The only difference between the claimed compound and the reference is at X, chloro versus cyano. The genus on page 1 of the Specification of the copending Application teaches that the cyano and chloro are alternatively useable, see page 1, line 17.

This is only one example found in the copending Application. Thus, said claims are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10532719. Although the conflicting claims are not identical, they are not patentably distinct from each other because the A-1 specie in Table 34, on page 13 and page 17, only differs from the claimed compounds in the following manner:

The instant Application claims compounds of formula (I), wherein X= cyano, R^2= hydrogen, R^1= CH_2CH_3 and the phenyl at the 6-position of the bicyclic skeleton is 2,6-dichlorophenyl.

The copending Application teaches compounds of formula (I), wherein X= cyano, R^2= hydrogen, R^1= CH_2CH_3 and the phenyl at the 6-position of the bicyclic skeleton is 2,4-dichlorophenyl.

The only difference between the claimed compound and the reference is the substitution at the 4- and 6-position of the phenyl ring at the 6-position of the bicycle. The compounds are positional isomers. The MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) …are generally of sufficiently close structural similarity that there is a presumed expectation that

such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). This is only one example found in the copending Application. Thus, said claims are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/
Examiner, Art Unit 1624

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624